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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------|-------------|----------------------|---------------------|------------------|
| 10/664,895 | 09/22/2003 | Takanori Kamoto | BJS-1114-190 | 6800 |
| 23117 | 7590 | 07/09/2007 | EXAMINER | |
| NIXON & VANDERHYE, PC | | | SHOSHO, CALLIE E | |
| 901 NORTH GLEBE ROAD, 11TH FLOOR | | | ART UNIT | PAPER NUMBER |
| ARLINGTON, VA 22203 | | | 1714 | |
| MAIL DATE | | DELIVERY MODE | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|---|------------------------|---------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. | Applicant(s) | |
| | 10/664,895 | KAMOTO ET AL. | |
| | Examiner | Art Unit | |
| | Callie E. Shosho | 1714 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 June 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) The period for reply expires 3 months from the mailing date of the final rejection.
 b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) They raise the issue of new matter (see NOTE below);
 (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. Applicant's reply has overcome the following rejection(s): _____.
 6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1,4,5,7-10 and 12-31.
 Claim(s) withdrawn from consideration: _____.
AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. Other: _____.

Callie E. Shosho
 Primary Examiner
 Art Unit: 1714

Attachment to Advisory Action

1. Applicants' amendment filed 6/25/07 has been fully considered, however, the amendment has not been entered given that the amendment raises new issues that would require further consideration and search.

The amendment raises new issues that would require further consideration under 35 USC 112, first paragraph. Specifically, claim 1 has been amended to recite "wherein a ratio of the aromatic dicarboxylic acid having a metal sulfonate group contained in the polybasic carboxylic acid ingredient is 0.5 mol% or more and 4 mol% or less". It is the examiner's position that this phrase fails to satisfy the written description requirement under 35 USC 112, first paragraph since there does not appear to be a written description requirement of the claimed upper limit of the amount of aromatic dicarboxylic acid having a metal sulfonate group contained in the polybasic carboxylic acid ingredient, i.e. 4 mol%, in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

As support for the amendment to claim 1, applicants' point to Table 1, page 57 of the present specification. However, while this portion of the present specification provides support to recite that 5-sodium isophthalate is present in amount of 4 mol% based on the amount of polybasic carboxylic acid ingredient, this does not provide support to broadly recite "wherein a ratio of the aromatic dicarboxylic acid having a metal sulfonate group contained in the polybasic carboxylic acid ingredient is 0.5 mol% or more and 4 mol% or less". That is, while there is support in the present specification to recite specific type of aromatic dicarboxylic acid having a metal sulfonate group, namely, 5-sodium isophthalate, is contained in the polycarboxylic acid ingredient in amount of 4 mol%, this does not provide support to broadly recite that the upper

limit of the amount of aromatic dicarboxylic acid having a metal sulfonate group contained in the polybasic carboxylic acid ingredient is 4 mol% given that the phrase "aromatic dicarboxylic acid having a metal sulfonate group" encompasses compounds other than 5-sodium isophthalate.

There is no support in the specification as originally filed to recite that all aromatic dicarboxylic acids having a metal sulfonate group contained in the polybasic carboxylic acid ingredient are present in amount of 4 mol% only 5-sodium isophthalate.

Further, the amendment raises new issues that would require further consideration and search in light of the amendment to claim 1 which has been amended to recite "wherein a ratio of the aromatic dicarboxylic acid having a metal sulfonate group contained in the polybasic carboxylic acid ingredient is 0.5 mol% or more and 4 mol% or less". Previously the upper limit of the amount of aromatic dicarboxylic acid having a metal sulfonate group contained in the polybasic carboxylic acid ingredient was 8 mol% while now the amount is 4 mol%. Such narrowing of the scope of the claims would require further consideration and search.

Further, even *if* the amendment were entered it is noted that the present claims would not be allowable over Breton et al. '209 (U.S. 5,777,209) in view of Breton et al. '108 (U.S. 6,384,108), Nagashima et al. (U.S. 4,625,220), and Endo et al. (U.S. 4,723,129) as set forth in paragraphs 8-11 of the office action mailed 3/23/07 or Reem et al. (U.S. 6,715,869) in view of Breton et al. '108 as set forth in paragraph 16 of the office action mailed 3/23/07 for the following reason.

Applicants argue, and the examiner agrees, that Breton et al. '108 discloses sulfonated polyester comprising 5-30 mol% aromatic dicarboxylic acid having metal sulfonate group based

on the amount of polybasic carboxylic acid ingredient. It is further agreed that Breton et al. '209 taken in view of the evidence given in Breton et al. '108 would no longer be applicable against the present claims under 35 USC 102. However, it is the examiner's position that the combination of Breton et al. '209 with Breton et al. '108 or Reem et al. with Breton et al. '108 would remain applicable under 35 USC 103. Breton et al. '108 disclose the use of polyester wherein the amount of aromatic dicarboxylic acid having a metal sulfonate group contained in the polybasic carboxylic acid ingredient is 5 mol% while the present claims require 4 mol%. However, it is apparent that the instantly claimed amount of aromatic dicarboxylic acid having a metal sulfonate and that taught by Breton et al. '108 are so close to each other that the fact pattern is similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a "slight" difference in the ranges the court held that such a difference did not "render the claims patentable" or, alternatively, that "a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties".

In light of the case law cited above and given that there is only a "slight" difference between the amount of aromatic dicarboxylic acid having a metal sulfonate contained in the polybasic carboxylic acid ingredient disclosed by Breton et al. '108 and the amount disclosed in the present claims, it therefore would have been obvious to one of ordinary skill in the art that the amount of aromatic dicarboxylic acid having a metal sulfonate contained in the polybasic carboxylic acid ingredient disclosed in the present claims is but an obvious variant of the

amounts disclosed in Breton et al. '108, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

With respect to Foucher et al. (U.S. 2003/0018100), the examiner appreciates applicants' clarification of their calculation regarding the amount of aromatic dicarboxylic acid having metal sulfonate group contained in the polybasic carboxylic acid ingredient of the polyester of example 1 of Foucher et al. However, it is still not clear why this amount of aromatic dicarboxylic acid having metal sulfonate group calculated by applicants based on the mol% of each polybasic carboxylic acid ingredient disclosed in example of Foucher et al. differs from the amount calculated by the examiner (see page 9 of the office action mailed 3/23/07) that is based on converting the amount of each polybasic carboxylic acid ingredient in grams to moles using the molecular weight and then calculating the mol% of aromatic dicarboxylic acid having metal sulfonate group. Clarification is requested.

Callie Shosho
Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
7/2/07